

USSN 09/938,940  
Page 4

### REMARKS

In response to the Office Action mailed July 25, 2003, Applicants respectfully request reconsideration of the above-identified application in view of the amendments and remarks presented herein.

Claims 14-17, 20-23, 34 and 35 were pending before entry of this Amendment. Claims 37-39 have been added with this Amendment. Support for the added claims can be found in the disclosure at, *inter alia*, page 6, line 7-13. Accordingly, claims 14-17, 20-23, 34, 35 and 37-39 will be pending after entry of the Amendment.

Corrected drawings are being sent under separate cover via United States First Class Mail as of January 26, 2004.

Applicants acknowledge the Double Patenting rejection on pages 7 and 8 of the Office Action. As per previous submission(s), Applicants respectfully request that the rejection be held in abeyance until allowable subject matter is found. Applicants will then shortly file a Terminal Disclaimer that will overcome the rejections.

Claims 14-17, 20-23, 34 and 35 were rejected under 35 USC, 112, first paragraph as, according to the Office Action, containing subject matter which was not sufficiently described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These rejections are traversed for the reasons presented herein.

Apparently, in making the above-mentioned Written Description rejection, the Office Action proffers the following two grounds of support: 1) there is no disclosure of any particular structure to function/activity relationship in the disclosed species; and 2) the specification fails to disclose additional representative species of these enzymes by any identifying structural characteristics or properties other than the activities recited for the disclosed

USSN 09/938,940

Page 5

species, for which no predictability of structure is apparent (see page 5, lines 1-9, of the Office Action).

The rejections are improper, as the Written Description requirement does not require a particular structure to function/activity relationship in the disclosed species or a particular number of disclosed species to satisfy the Written Description requirement (see, e.g., MPEP 2163 et. seq.; also see official guidelines published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov)).<sup>1</sup> Rather, as has been stated in the previous Response (see Paper No. 13, 5/12/2003), the Written Description requirement has been satisfied if one skilled in art can recognize what has been invented, and one skilled in the art would be able to recognize the claimed invention for the reasons set forth herein, as well as in previous remarks. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Additionally, newly added claims 37-39 satisfy the Written Description requirement for the reasons presented herein. Applicants respectfully request that these claims be entered and allowed with the rest of the case.

Claims 14-17, 20-23, 34 and 35 were rejected under 35 USC 112, first paragraph because, according to the Office Action, the claims are not enabled for the entire scope. These rejections are traversed for the reasons set forth herein.

Apparently, the Office Action has deemed that the claims are not enabled because Applicants have not taught one skilled in the art how to make **and**<sup>2</sup> use the invention for the full scope of the claims, as the claims are unreasonably broader than the disclosed teachings.

<sup>1</sup> The present Office Action does not contain valid grounds for either the Written Description or enablement requirement, as stated below; the Examiner is reminded that he bears the burden of establishing a *prima facie* case for the rejection.

<sup>2</sup> The bold text in the Office Action is thought to be a typographical error. Bold type is normally used for emphasis, and, given the context of the Office Action and the case, there is no reason why the Office Action would employ bold text. As can be seen from the case, Applicants have satisfied both prongs (make and/or use) of the enablement requirement and, thus, the bold type can not be for emphasis of the requirement for make and use. In any case, the Examiner bears the burden of establishing a *prima facie* case, which he has not done (see, footnote 1).

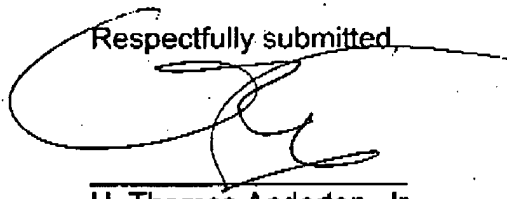
USSN 09/938,940  
Page 6

But, as the claims do not require undue experimentation, they are fully enabled. Applicants have taught one skilled in the art how to make all claimed species without undue experimentation; and, Applicants have taught how to test for functionality (i.e., the use component implied in the rejection set forth in the Office Action) for each species (see, e.g., pages 10-16 of the disclosure). One skilled in the art would merely have to make one of the species, and then one skilled in the art could screen that species (or many at the same time, as disclosed) for functionality according to the specification; such experimentation is not undue. Accordingly, the claims are enabled, and reconsideration and withdrawal of the rejections are respectfully requested.

Additionally, newly added claims 37-39 satisfy the Enablement requirement for the reasons presented herein. Applicants respectfully request that these claims be entered and allowed with the rest of the case.

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance and issuance of a formal Notice of Allowance is respectfully requested. Examiner Hutson is invited to contact Applicants at (650) 846-7544 if there are additional questions/concerns.

Respectfully submitted,



H. Thomas Anderton, Jr.  
Registration No. 40,895

Date: January 26, 2004

Genencor International, Inc.  
925 Page Mill Road  
Palo Alto, CA 94304-1013  
Tel: 650-846-7544  
Fax: 650-845-6504